Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN JOHN FOUND, ALEX MILLAR and EDDIE SHELL

Appeal No. 2003-1317
Application 09/043,787

ON BRIEF

Before THOMAS, KRASS and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 46-86, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for operating a mystery jackpot at a plurality of gaming venues each having electronic gaming machines (EGMs) which

are of a type which are designed for independent gaming operation.

Representative claim 46 is reproduced as follows:

46. A method of operating a mystery jackpot at a plurality of gaming venues each having electronic gaming machines (EGMs) which are of a type which is designed for independent gaming operation and which each includes EGM logic and hardmeters and wherein the EGM logic generates hardmeter signals for inputting to said hardmeters, the method comprising:

providing a jackpot controller at each venue;

adding a jackpot interface to the EGM logic of selected EGMs at each gaming venue to thereby define a group of said EGMs at each venue for participation in the mystery jackpot;

coupling said group of EGMs to the jackpot controller via a venue network;

coupling the jackpot controller to a communications network for communication with a central controller;

causing the jackpot interface of each EGM of said group to monitor its internal hardmeter signals;

causing the jackpot interface to transmit first signals to said jackpot controller via said venue network when hardmeter signals are detected;

transmitting the first signals from the jackpot controllers at the venues to said central controller via said communications network;

establishing a random jackpot value and a jackpot pool in the central controller;

altering the jackpot pool in response to first signals received at the central controller;

detecting when a predetermined relationship exists between said random jackpot value and said jackpot pool;

generating a jackpot win message which is transmitted from the central controller via the communications network to the jackpot controller at that venue

which caused said jackpot pool to have said predetermined relationship with said random jackpot value; and

causing the jackpot controller which received said jackpot win message to send a jackpot award message via said venue network to one of the EGMs in the group whereby the receipt of the jackpot award message by said one EGM is independent of the gaming results at said one EGM.

The examiner relies on the following references:

Tracy	5,116,055	May 26, 1992
Weiss	5,611,730	Mar. 18, 1997
Acres et al. (Acres)	5,820,459	Oct. 13, 1998

Claims 46-86 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Weiss in view of Acres and Tracy.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's

rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 46-86. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

With respect to independent claim 46 and dependent claims 47-53, which stand or fall together as a single group [brief, page 4], appellants argue that their invention is applicable to gaming venues which have the same or different EGMs therein

whereas Weiss requires the participating EGMs to be of the same type. Appellants also argue that Weiss fails to teach or suggest the monitoring and detection of hardmeter signals. Appellants argue that there is no need to monitor hardmeter signals in order to be involved in a jackpot award process. Appellants also argue that Acres relates to a single venue only and does not have an enabling disclosure for implementing a mystery jackpot. Appellants note that the discrete signals of Acres are not the same as the claimed hardmeter signals. With respect to Tracy, appellants argue that Tracy does not teach hardmeter signals or machines not ordinarily designed for use in a network. Finally, appellants argue that Weiss does not teach or suggest the feature of the award of the jackpot being independent of the gaming results of the one EGM [brief, pages 8-14].

The examiner responds that Weiss teaches different EGMs at column 1, lines 30-35, column 3, lines 49-53 and column 9, line 65 to column 10, line 3. The examiner also responds that the various signals monitored by Weiss suggest the monitoring of hardmeter signals as claimed. The examiner disputes appellants' assertion that there is no need to monitor hardmeter signals for awarding a jackpot because the amount of money played is necessary to determine the jackpot winner. The examiner notes

that Acres was cited to teach the obviousness of a mystery jackpot. The examiner notes that the disclosure of Weiss would have suggested to the artisan that the amount of money played could be determined by monitoring either hardmeters or softmeters. Finally, the examiner responds that the mystery jackpot in Acres is awarded to a particular machine independent of the gaming result of that machine [answer, pages 3-10].

We will sustain the examiner's rejection of claims 46-53 for essentially the reasons argued by the examiner in the answer. For the most part, the examiner's responses to appellants' arguments provide a convincing rebuttal to appellants' arguments. With respect to the hardmeter arguments, we find that even though the prior art references may not specify that hardmeter signals are used, we agree with the examiner that it would have been obvious to the artisan to use hardmeter signals. For purposes of awarding a mystery jackpot in Weiss as taught by Acres, it is necessary to transmit signals regarding the amount of money played. Since the amount of money played is known to be stored in the hardmeters, it would have been obvious to the artisan to use this known source of money played signals for determining when the mystery jackpot should be awarded.

With respect to independent claim 54 and dependent claims 55-59, which stand or fall together as a single group [brief, page 4], appellants argue that claim 54 is similar to claim 46 except that credit played signals are used instead of hardmeter signals [brief, page 15].

We will sustain the examiner's rejection of claims 54-59 for the reasons discussed above with respect to claim 46. Weiss teaches a jackpot system that is credit/debit and cashless capable [column 2, lines 65-66]. Therefore, Weiss teaches using credit played signals for purposes of determining a jackpot winner.

With respect to independent claim 60 and dependent claims 61-64, which stand or fall together as a single group [brief, page 4], appellants argue that claim 60 is similar to claim 46 with the addition of a jackpot interface [brief, page 15].

We will sustain the examiner's rejection of claims 60-64 for the reasons discussed above with respect to claim 46. It would be clear to the artisan that each of the participating EGMs in the Weiss-Acres gaming system must have an interface to the monitor host so that each EGM can collectively participate in a mystery jackpot.

With respect to independent claim 65 and dependent claims 66-68, which stand or fall together as a single group [brief, page 4], appellants argue that claim 65 is similar to claim 54 with the addition of a display of the jackpot award [brief, page 16]. The examiner notes that Weiss teaches a display screen on the EGMs [answer, page 11].

We will sustain the examiner's rejection of claims 65-68 for the reasons discussed above with respect to claim 54. The collective teachings of the applied prior art teach displaying the amount of a jackpot award at a gaming machine.

With respect to independent claim 69 and dependent claims 70-76, which stand or fall together as a single group [brief, page 4], claims 77-82, which stand or fall together as a single group, and claims 83-86, which stand or fall together as a single group, appellants argue that these claims are respectively similar to claims 46, 54 and 60 [brief, pages 16-17].

We will sustain the examiner's rejection of claims 69-86 for the reasons discussed above with respect to claims 46, 54 and 60.

In summary, we have sustained the examiner's rejection of the claims on appeal with respect to each group of claims. Therefore, the decision of the examiner rejecting claims 46-86 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS Administrative Patent Judge	)	
ERROL A. KRASS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JERRY SMITH Administrative Patent Judge	)	

JS/ki

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714